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OCT 21 2009

OFFICE OF PETITIONS

In re Application of
Drummond et al.
Application No. 09/193,787
Filed: November 17, 1998
Attorney Docket No. D-1077+1
For: AUTOMATED BANKING MACHINE
APPARATUS AND SYSTEM

DECISION ON PETITION

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term modification entitled "Request for Patent Term Review," received on June 29, 2009. The request is being treated as a petition for corrected patent term extension under 37 CFR 1.701 and 37 CFR 1.181, a request for reconsideration of the patent term adjustment under 37 CFR 1.705 and a petition under 37 CFR 1.182 as Petitioner has argued patent term adjustment provisions and other provisions.

The petition under 37 CFR 1.181 is dismissed.

The request under 37 CFR 1.705 is dismissed.

The petition under 37 CFR 1.182 is dismissed.

Petitioner notes that the Notice of Allowance mailed on April 30, 2009, for the above-identified application did not contain an indication of patent term modification under 35 U.S.C. § 154(b). Petitioner contends that the instant application is entitled to at least six years (2,190 days) of patent term modification.

Petitioner asserts that the patent is entitled to patent term adjustment based on the Patent term Guarantee Act of 1999. Petitioner asserts that 37 CFR 1.702 applies to applications "filed" on or after May 29, 2000 and since the application was pending and had a filing date when the legislation went into effect, that the patent is entitled to patent term adjustment under the patent term adjustment provisions.

Petitioner asserts that the application is not subject to a terminal disclaimer that expressly states an expiration date, thus the patent will not be subject to a terminal disclaimer under the provisions of 35 U.S.C. 154(b)(2)(B). Additionally, Petitioner asserts that there were no circumstances where applicant failed to engage in reasonable efforts to conclude processing the present application.

Petitioner asserts that for the purposes of 37 CFR 1.702, the present application was filed on May 29, 2000, and three years after this date is May 29, 2003. As a result, Petitioner asserts the application is entitled to at least six years of patent term modification.

Petitioner asserts regardless of the decision for patent term modification (adjustment and/or extension), applicant should be entitled to additional patent term under 37 CFR 1.182 (or another pertinent rule) due to the extraordinary length of prosecution history. Petitioner asserts that prosecution was improperly reopened many times both with many non-final office actions and reopening of prosecution after submission of the appeal brief.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000).

The above-identified application was filed on November 17, 1998. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Petitioner's assertion that the application is eligible for patent term extension provisions pursuant to 35 U.S.C. 154 and 37 CFR 1.701 is not persuasive. While the application was issued pursuant to an adverse determination of patentability by the BPAI, which may make it eligible for patent term extension under 35 U.S.C. § 154, the application is subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct.

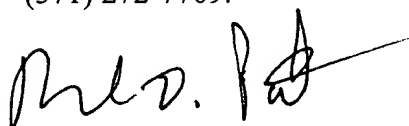
The statute states that a "patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review" and the patent that is to be issued is subject to a terminal disclaimer, see 35 U.S.C. 154(b)(2), 37 CFR 1.701(a)(3) and *Changes to Implement 20-Year Patent Term and Provisional Applications*, 60 FR 20195 (April 25, 1995).

Petitioner's assertion that the application is eligible for patent term adjustment provisions pursuant to 35 U.S.C. 154 and 37 CFR 1.702 -1.705 because the application was still pending when the legislation became effective is not persuasive. The effective date provision (§ 4405) in the legislation clearly states that the amendments to 35 U.S.C. § 154 apply to applications filed on or after the date that is 6 months after the date of enactment, i.e., May 29, 2000. This provision does not include applications that were filed prior to the date of enactment or even immediately after the date of enactment, but applications that were filed on or after the date that is 6 months after the date of enactment, see *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 FR 56366 (Sept. 18, 2000) 1239 Off Gaz. Pat. Office Notices 14 (Oct. 3, 2000).¹

Petitioner's assertion that the application is eligible for additional patent term under 37 CFR 1.182 due to the extraordinary length of the prosecution history is not persuasive. The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

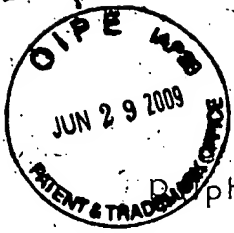
The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41 (a)(7). The required \$200 fee for the petition under 37 CFR 1.705(b) and \$400 fee for the petition under 37 CFR 1.182 petition has been charged to Deposit Account 09-0428.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

¹ Sykes v. Dudas, 573 F.Supp 2d 191, 89 USPQ2d 1423 (D.D.C.2008).



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June 29, 2009

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01 FC:1462
02 FC:1455

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Commissioner for Patents
PO Box 1450
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Re: **Application No.:** 09/193,787
Confirmation No.: 2446
Applicants: Jay Paul Drummond, et al.
Filed: November 17, 1998
Title: Automated Banking Machine Apparatus and System
Art Unit: 3685
Notice of Allowance Date: April 30, 2009
Docket No.: D-1077+1

Sir:

Please find enclosed the Issue Fee Transmittal form for filing. Also enclosed are a Request for Patent Term Review, "Comments on the Statement of Reasons for Allowance," and "Comments on the Substance of Interviews."

If necessary, please charge the appropriate Patent Term Review fee required (either 37 CFR 1.17(h) or 37 CFR 1.18(e)), and any other fee due, to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop ISSUE FEE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this day 29 of June 2009.

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